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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,943	12/27/2000	Gregory C. Flickinger	T721-17	6477
27832	7590	01/12/2005	EXAMINER	
TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME			BUI, KIEU OANH T	
6206 KELLERS CHURCH ROAD			ART UNIT	
PIPERSVILLE, PA 18947			PAPER NUMBER	
			2611	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/748,943	<b>Applicant(s)</b> FLICKINGER ET AL.	
	<b>Examiner</b> KIEU-OANH T BUI	<b>Art Unit</b> 2611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 and 34-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 34-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-16 were canceled without prejudice (paper no. 7). Claims 17-36 are added (paper 7) and claims 37-62 are added (paper 18), and new claims 63-69 are added (10/7/04). Claim 33 was canceled. Pending claims are now claims 17-32 and 34-69.

***Response to Arguments***

2. Applicant's arguments with respect to claims 17-32 and 34-69 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

4. Claims 17-32 and 34-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldering et al. (US Patent 6,704,930 B1).

The applied reference has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 17, 27 and 32, Eldering discloses “in a television network environment consisting of a display device and a storage medium, a method for delivering targeted advertisements to subscribers in advance of presentation of the advertisements to the subscribers”, i.e., set top terminal receives advertisements from a headend system or ad server 106 via a network 104 and stores the ads before presentation to subscribers (Fig. 10 for storage medium 114 before presentation to the user, col. 8/lines 40-53), the method comprising: “transmitting advertisements within an advertisement channel to subscribers in advance of presentation of the advertisements to the subscribers; wherein the advertisements are transmitted at a bit rate that is less than the bit rate required to present the advertisement in real time; and storing the advertisements in a storage medium” (Fig. 9, col. 7/lines 15-55 for a separate ad channel addressed, and col. 1/line 55 to col. 2/line 18 as constant bit rate and available bit rate, and in-band or low bandwidth is for real-time delivery and out-of-band or high bandwidth band is for pre-stored at a storage medium, more in col. 5/lines 54-67 for dynamically bandwidth allocation for low bandwidth signal/channel).

As for claims 18-22, 28-29 and 36, in view of claim 17 above, Eldering further discloses the steps of “wherein said transmitting includes transmitting the targeted advertisements”; “wherein the targeted advertisements are selected for the subscribers based on subscriber characteristics”; “wherein the subscriber characteristics includes at least some subset of demographic attributes, geographic attributes, psychological attributes, and viewing attributes”; further comprising “forming subgroups of subscribers that share one or more common subscriber

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characteristics, wherein said transmitting includes transmitting the advertisements to the subgroups”; and “selecting targeted advertisements for the subgroups, wherein said transmitting includes transmitting the targeted advertisements to the subgroups”, i.e., a variety of techniques in targeting advertisements to users using demographics and viewing habits (Fig. 11, and col. 8/line 54 to col. 9/line 24).

Regarding claims 23-26, 30-31 and 34, Eldering further shows “transmitting the advertisements within the advertisement channel at a constant bit rate, a variable bit rate that changes over time according to the amount of bandwidth available for the advertisement channel, wherein the bandwidth available for the advertisement channel is based on bandwidth used and total bandwidth of the television network, wherein the bandwidth used includes bandwidth used for transmitting programming channels”, i.e., a dynamic allocation technique where low bandwidth or high bandwidth can be used effectively including the ad channels (col. 3/lines 55-65, col. 5/lines 27-67 as each program stream can be adjusted to a predetermined constant bit rate and the synchronization of the ads and/or ad channel).

As for claim 35, in further view of claim 32 above, Eldering further inherently discloses “wherein said transmitting includes transmitting the advertisement off-peak”, i.e., based on the determination of the viewer’s demographics characteristics, the ad can be transmitted at any later time including off-peak time (col. 6/lines 16-36, col. 6/line 65-col. 7/line 8 and col. 9/line 53 to col. 10/line 8 for an ad manager determines the appropriate times for delivery ad channel containing ads).

As for claim 37-40, Eldering discloses a method for receiving advertisements for storage, comprising receiving advertisements over same medium as content is received, and transmitted at a low bit rate; and storing the advertisements in a storage medium; then retrieving the advertisements from the storage medium, and presenting the advertisements to the subscribers (col. 1/line 55 to col. 2/line 11 for advertising data is transmitted data distributing either in real time and non real-time, using low or less bit rate required as for real-time transmission, col. 5/lines 54-67, and the ads is stored at local storage and the presentation is displaying to the user at a later time addressed in col. 6/lines 17-64 & col. 8/lines 40-53 for storage medium).

As for claims 41 and 42, Eldering further discloses an acceptable viewing quality is displaying the advertisement using low bit rate that is less than a bit rate required to present in real-time (col. 5/lines 54-67 for low bandwidth signal using low CBR as discussed earlier, and col. 7/lines 28-55 as standard or high definition format can be used).

As for claims 43-46, Eldering inherently discloses “the low bit rate is a bursty bit rate”; “the receiving advertisement in a discontinuous fashion” and “over a plurality of discontinuous streams”; and “the low bit rate utilizes leftover bandwidth in the medium” (Fig. 6, col. 4/lines 38-67, and col. 5/line 27 to col. 6/line 9).

As for claims 47-62, these claims are rejected for the reasons given in the scope of claims 37-46, with multiplexing technique also disclosed by Eldering not limited to Figs. 1-11, and col. 3/line 55 to col. 52 but through out the reference.

As for claims 63-69, these claims with same limitations addressed earlier in claims 17-32 are rejected for the reasons given in the scope of claims 17-32 as discussed above.

***Conclusion***

**5. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9306, (for Technology Center 2600 only)

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant, can be reached on (703) 305-4755.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui  
Art Unit 2611  
Jan. 04, 2005



KRISTA BUI  
PATENT EXAMINER